

Application No.: 10/670,974
Attorney Docket No.: 21882-0001

REMARKS

Applicant wishes to note that counsel for applicant has attempted to reach the Examiner by telephone on at least two separate occasions, and has left voicemail messages for the Examiner on two occasions. Counsel for Applicant has to date not received a return phone call. It is with regret that this Response is filed without the benefit of conversing with the Examiner, since Applicant believes that this conversation would advance the prosecution of the case.

Applicant hereby affirms its previous election of the claims of Species I, with traverse. To clarify the Applicant's election and comply with the requirement that Applicant "list" the claims directed to that species, claims 1-20 are all directed to Species I. Applicant notes that the original claims have not been examined, and there is no requirement that Applicant provide a "listing of claims" or to designate any claims with a new status such as would accompany a response to a substantive Office Action on the merits.

To recap Applicant's previous response and arguments, the statement of the restriction identifies a purported five (5) species based solely on the figures presented in the application. The statement does not attempt to associate particular claims with each species, but notes that "at least claims 1, 16 and 17 are generic." Applicant agrees that at least claims 1, 16, and 17 are generic. Those claims are all directed to Species 1.

The basis of the traverse is as follows. The restriction is made pursuant to 35 USC 121. The claims must be shown to be "independent and distinct" to maintain the restriction, 35 USC 121, 37 CFR 1.142, MPEP 802. Since this requirement is statutory, it is not proper to interpret the statute in any other fashion.

The restriction does not assert that the purported species are "distinct", and certainly does not address the question of whether they are "independent", as required by the statute, the regulation, and the MPEP. Applicant submits that the inventions of Species I-IV are not "independent". The term "independent" is defined in MPEP 802.01:

Application No.: 10/670,974
Attorney Docket No.: 21882-0001

"The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect . . ."

The restriction can be made only "If it can be shown that the two or more inventions are in fact independent . . .", MPEP 806.04.

As made quite clear in the specification, the subject matter of Species I-V are not "independent" and "distinct". Specifically, the disclosed relationship between Species I and Species II is that "Species II", as illustrated in FIG. 5, is the same protruding edge 52 species of the attachment means 50 that is shown in FIGS. 1-3 of Species I. See paragraph [0025]. While this relationship is clear from the application as filed, Applicant has submitted an amendment herewith to more clearly to correlate the common elements of FIGS. 1-5 by correcting references to elements 50 and 52 in the specification at paragraph [0024]. "Species" III-V illustrate alternate versions of the common element of attachment means 50. However, notably, all of "Species" I-V comprise attachment means 50, and are therefore part of the same genus.

Independent claim 1 is a generic apparatus claim that covers Species I. Dependent claims 2-15 are related as species of generic claim 1. Independent claim 16 is a generic method claim that can only be practiced using the invention of claim 1 or claim 17. Lastly, independent claim 17 is a generic claim that also covers Species I, with dependent claim 18 including attachment means limitations, and with dependent claims 19-20 including further limitations of the backing features of Species I.

Additionally, there has been no showing that a search of the species would place any undue burden on the Examiner, and all should be searched. MPEP 803 states "If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." [Emphasis added] Given that 37 CFR 1.104(a) mandates a thorough examination, which would presumably include searching in both

Application No.: 10/670,974
Attorney Docket No.: 21882-0001

art classes, the mandate of MPEP 803 requires that all specie of the invention be examined. If the restriction is maintained, Applicant asks that the Examiner demonstrate why a search would pose a serious burden, and in fact why all species should not be searched to meet the thoroughness requirement. Applicant wants a thorough search of its invention, and is concerned that the search may be less than thorough if certain search classes are arbitrarily excluded for restriction reasons.

For these reasons, the claims should be examined in the same application, pursuant to the various statutes, regulations, and MPEP sections set forth herein. Applicant asks that the Examiner reconsider and withdraw the restriction requirement as to Groups I-V.

Applicant requests a prompt and favorable action by the Examiner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.


The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,

Dated: April 1, 2005

McNees Wallace & Nurick LLC

Phone: (717) 232-8000
Fax: (717) 237-5300


Kurt L. Ehresman
Reg. No. 50,758
100 Pine Street
P.O. Box 1166
Harrisburg, PA 17108-1166